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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,020	04/17/2006	Philipp Schafer	288936US0PCT	9311
22850	7590	03/06/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER AHVAZI, BIJAN	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			03/06/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.		Applicant(s)	
	10/576,020		SCHAFFER, PHILIPP	
	Examiner		Art Unit	
	Bijan Ahvazi		1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/17/2006 & 10/04/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicant's election of Group I, claims 1-15, 19 and 20 with traverse in the reply filed on 01/05/2009 is acknowledged. Claims 16-18 is previously withdrawn from consideration as a result of a restriction requirement now subject to being rejoined. Claims 16-18 is hereby rejoined and fully examined for patentability under 35 U.S.C. 371

Since all claims from consideration have been rejoined, the restriction requirement made in the Office action mailed on 12/05/2008 is hereby withdrawn.

Specification

2. The disclosure is objected to because of the following informalities: The proper unit is required for pressure in ¶ 0016. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 recites "...a mixture of water and a solvent...." in line 6 render the claim indefinite because water is considered to be a solvent. Claims 12,13 and 14, being depended on claims 11, are rejected as well.

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5. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites "...the formation of the hollow microspheres in the region adjacent to the to the at least one defect on the surfaceis greater than....." in line 3 render the claim indefinite because it is unclear that the term "greater than" is compared to what element in the recited claim.

Claim Rejections - 35 USC § 102.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 7, 11-13, 16, 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Philip Schaefer (EP 1300474 A1, machine translation).

8. Philip Schaefer (EP 1300474 A1, machine translation) discloses a full grain napa cowhide which exhibits the characteristics with respect to grain pipeyness and water vapor permeability that are required by the automotive and upholstery industries, a finish is applied to the grain side of the full grain leather. The finish includes a pigmented layer with a thickness of between 0.015 mm and 0.04 mm and is formed of a stabilized polyurethane and/or polyacrylate dispersion. The dispersion contains microspheres with a diameter of less than 45 µm, which form primarily closed cells, and at least 10% open cells by volume. The top side of the layer is provided with a napa embossing. A second layer, placed on the first layer, is formed from a

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cross-linked polyurethane-based varnish application containing a dulling agent. The leather undergoes a milling treatment (Abstract). Philip Schaefer discloses a process for coating the grain layer of full-grained cattle leather, in which an aqueous polymer dispersion containing polyurethane and/or polyacrylate and additionally isobutene filled hollow microspheres having a diameter or less than 45 μm or compact particles (Col. 4, ¶0018) from which such hollow microspheres can be formed in situ by heating is applied to the leather, with the solidified polymer dispersion being applied under pressure and with heating at an embossing temperature below 120 °C by means of an embossing roller having a finely structured surface corresponding to the napa grain structure, and the resulting fully-grained napa cattle leather to which the polymer dispersion has been applied and thus pressed into the defects (Col. 5, ¶0019). The process serves to cover surface defects in the hide (Col. 10, ¶0044) which corresponding to the instant applicant's limitation claims 1-5, 7, 16, 17 and 20. Philip Schaefer also discloses the interspaces between the hollow microspheres form the open cells which are needed for the water vapor permeability and breathability. These open cells can be further multiplied by inventively opening the thin shells of individual hollow microspheres by mechanical and/or chemical means, so that individual hollow microspheres thereby also form open cells. To accomplish this, the second layer can inventively contain a solvent such as ethylacetate or methylethylketone which partly dissolves the thin shell of individual hollow microspheres. Individual microspheres can also be opened mechanically, for instance by inserting needles into their shells (Col. 3, ¶0011) which corresponding to the instant applicant's limitation claims 11, 12 and 13. The method of correcting at least one defect of Philip Schaefer would inherently possess the recited limitation because same ingredients and condition are utilized. Philip Schaefer teaches all the limitations of the instant claims. Therefore claims 1-5, 7, 11, 12, 13, 16 and 17 and 20 are as being anticipated by Philip Schaefer.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 8-10, 14, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Philip Schaefer (EP 1300474 A1, machine translation) as applied to claims 1-5, 7, 11-13, 16, 17 and 20 above, and further in view of Will Helmut (DE 3921145A1, machine translation).

11. Philip Schaefer discloses the features as discussed above. Philip Schaefer discloses that the grain side of the full grain napa cowhide which consists of a stabilized dispersion containing polyurethane (e.g thermoplastic) and/or polyacrylate and comprising primarily hollow microspheres have a thin shell which consists of at least 75% polyvinylidene chloride and less than 25% polyacrylnitrile, and they contain a heavy gas, preferably isobutene (Col. 7, ¶0031) in their interior (reads on a liquid blowing agent) with the embossing of the first layer with the aid of pressure and heat, the shells of some of the microspheres are ruptured given an embossing temperature below 120 °C which corresponding to the instant applicant's limitation claims 9 and 10.

Philip Schaefer discloses that the embossing expediently occurs with the aid of an embossing roll with a temperature between 80 to 120 °C (Col. 5, ¶0021) whereby the thermal contact between the embossing roll and the first layer lasts less than 2 seconds which corresponding to the instant applicant's limitation claim 6. The surface of the embossing roll

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comprises depressions corresponding to the napa grain structure that is to be produced, into which portions of the first layer penetrate (by foaming) during embossing, so that the desired napa graining emerges which corresponding to the instant applicant's limitation claim 19.

Regarding the recited range in the instant applicant's limitation claims 6, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that choosing the over lapping portion, of the range taught in the prior art and the range claimed by the applicant, has been held to be a ***prima facie*** case of obviousness, see *In re Malagari*, 182 USPQ 549.

Regarding the recited mixture comprises 90 parts of water and 10 parts of ethyl acetate in the instant applicant's limitation claim 14, it is the examiner's position that since it has been held that where general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 223). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within generic disclosure of the prior art.

Philip Schaefer further discloses that the process wherein the first layer, namely the foam-like pigmented layer, comprises hollow microspheres with a small diameter which are arranged closely adjacent one another and which brace against one another, preventing bursting of the thin shells under stress and escaping of the gas (Col. 3, ¶0012) which corresponding to the instant applicant's limitation claim 15. It would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive compact particles comprising pigmented compact particles whose color correspond to that of the grain layer because the disclosure of the inventive subject matter appears within generic disclosure of the prior art. However, Philip Schaefer fails to disclose that the process,

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wherein the compact particles having a size of less than 10 μm are used in an amount of from 15 g to 60 g, based on 1 kg of 40% strength aqueous, plastics dispersion. Will Helmut discloses the use of microcapsules with an average particle size from 2 to 50 μm (Page 2, ¶6, line 1) with the recited amount as shown in Example 3 (Page 3, ¶4, lines 1-7) corresponding to the instant applicant's limitation claim 8. It is held that a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (MPEP 2144.05). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within generic disclosure of the prior art.

Examiner Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijan Ahvazi, Ph.D. whose telephone number is (571)270-3449. The examiner can normally be reached on M-F 8:0-5:0. (Off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the

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/BA/
Bijan Ahvazi,
Examiner
Art Unit 1796

/Ling-Siu Choi/
Primary Examiner, Art Unit 1796

02/10/2009